

REMARKS

Claims 1-67 are pending in the application. In the Office Action of June 10, 2002, the Examiner rejected claims 1-67 under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto (U.S. Patent No. 6,078,663) in view of Barbcr (U.S. Patent No. 5,930,777). Applicants amended claims 1, 19, 22, 31, 49 and 50 to more clearly point out and distinctly claim their invention, and presented arguments distinguishing the claimed invention over the cited references. In the Final Office Action of November 6, 2002, the Examiner rejects claims 1-67 under 35 U.S.C. §103(a) as being unpatentable over Yamamoto (U.S. Patent No. 6,078,663) in view of Council (U.S. Patent No. 6,192,114). Applicants now further amend claims 1, 19, 22, 31, 49, and 50 to place the case in form for allowance or in better form for appeal.

In particular, the independent claims have been amended to clarify that, in the claimed embodiments, the information sent by the sender is received at a public fee address, and that the information received at the public fee address is forwarded to the recipient at a private address associated with the mail recipient. Support for all amendments is found throughout the specification as filed. Applicants believe these features were present in the previous claims and that the amendments merely serve to further clarify the claimed embodiments, placing the case in form for allowance or in better form for appeal. No new matter is believed to have been added by these amendments. Reconsideration and further examination are therefore respectfully requested.

Rejections Under 35 U.S.C. §103(a)

Claims 1-67 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yamamoto (U.S. Patent No. 6,078,663) in view of Council (U.S. Patent No. 6,192,114). Applicants respectfully traverse this ground of rejection.

As described in Applicants' previous response, the Yamamoto patent describes a system related to the enciphering and deciphering of transmitted data. As described in the Abstract, the Yamamoto reference relates to a communication device that includes an accounting circuit for calculating an amount to charge a user for data. The Examiner points out that the Yamamoto patent describes an information providing center for providing information to a user, at the request of the user. The user is charged for information provided to him (e.g., based on the amount of information which he requested).

The Council patent describes a method for screening messages sent to registered recipients of a system. In particular, the Council patent describes a method for identifying incoming messages to identify the sender of the message. If the sender of the message is not listed on an authorization list, a fee is charged to the sender before the message is passed on to the designated recipient. The authorization list includes a list of preauthorized addresses that each recipient is willing to receive mail from. If the sender's address is on the list, no fee is charged, and the mail is passed on to the recipient (e.g., at the address provided in the original message). If the sender's address is not on the authorization list, Council's system determines and charges a fee to the sender before delivery takes place. If the sender does not authorize the charge, the mail is generally discarded.

Claim 1

Applicants respectfully assert that the Yamamoto and Council patents fail to teach, suggest, or render obvious, either alone or in combination, embodiments of the present invention as recited in amended claim 1. In particular, the Yamamoto and Council patents fail to disclose, teach, or suggest a method that includes: (1) receiving information at a public fee address and forwarding the information to a private address (both addresses being associated with a mail recipient), or (2) charging the sender a fee based on criteria established by the recipient.

Nowhere in the Yamamoto patent is receiving information at a public fee address and forwarding the information to a private address taught or suggested. The Examiner agrees that the Yamamoto patent fails to describe this feature (see Paper No. 5, pg.2, lines 1-3). The Examiner cites the Council patent to make up for the deficiency of Yamamoto, and in particular refers to Council's Abstract, Fig. 1, Fig.2, and Col. 4, lines 8-55 as providing the feature missing from Yamamoto. Applicants have reviewed the sections of the Council patent cited by the Examiner and respectfully disagree that this, or any other portion of the Council patent teaches or suggests the feature of receiving information at a public fee address and forwarding the information to a private address. Applicants respectfully request that the Examiner more clearly point to the alleged teaching in Council.

The address described in the Council patent is not a private address. A private address as described in the present invention is an address not generally available to the public. In the Council patent, the sender has access to and addresses mail to one address: The public address of the recipient. The Council system captures the message, checks the sender's address to see if it is

on an authorized list, and if it is, the message is allowed to pass to the addressed recipients' address. There is no forwarding from a public fee address to a private address because there is only a single address associated with the recipient.

In the embodiment recited in claim 1 of the present application, the sender only has access to and only addresses mail to the recipient's public fee address, even though the recipient maintains a separate private address. Mail is then forwarded to the recipient's private address when fees are appropriately calculated and collected. The sender does not generally have access to the recipient's private address. This embodiment of the present invention ensures privacy for the recipient and enhances the security and effectiveness of the fee address system. Because neither Yamamoto or Council, alone or in combination, teach or suggest a system in which information is received at a public fee address and then forwarded to a private address (both associated with a mail recipient), claim 1 is believed patentable over the cited references.

Further, claim 1 is believed patentable over the cited references because neither reference, alone or in combination, teach or suggest charging the sender a fee based on criteria established by the recipient. The Examiner argues that the Yamamoto patent does teach this feature (referring to Yamamoto's Abstract, Figs. 4 and 7, col. 11, lines 45-64 and col. 12, lines 35-59). Applicants have reviewed the sections of Yamamoto referenced by the Examiner and respectfully disagree that this, or any other, portion of the Yamamoto patent teach or suggest charging the sender a fee based on criteria established by the recipient.

The sender described in the Yamamoto patent is an information provider, and the recipient is the information requester. In complete contrast to embodiments of the present invention (which allow a recipient to specify fees to assess to information sent by senders), the Yamamoto patent describes a method where the provider of information (the sender) establishes fees to charge the recipient of the information. To modify the Yamamoto patent to charge the sender based on recipient criteria would frustrate the purpose of the Yamamoto patent in collecting fees for the distribution of information from the sender.

The Council patent fails to make up for the deficiencies of the Yamamoto patent, also failing to teach or suggest charging the sender a fee based on criteria established by the recipient. While the Council patent does describe charging a fee to the sender, the fee is determined by a central system, not by the recipient. As a result, Applicants respectfully assert that neither the

Yamamoto or the Council references teach or suggest embodiments of the present invention as recited in claim 1.

Further, Applicants respectfully assert that it would not have been obvious to make the combination suggested by the Examiner. The Yamamoto reference involves a system which operates to pass information upon a request by a user (e.g., the recipient of information). The Council reference involves a system which prevents certain information from passing to an intended recipient. Applicants respectfully assert that it would not have been obvious to modify the Yamamoto system to include features of Council which prevent certain messages from passing to the recipient as the combination would render the Yamamoto system inoperable for its intended purpose. Further, Applicants respectfully urge that the Examiner has not established a proper prima facie case of obviousness in combining the two references, as the Examiner has not pointed to a specific teaching in either reference which would have motivated one of ordinary skill in the art to make the combination proposed by the Examiner. Applicants respectfully assert that claim 1, as amended, is patentable over the cited references, alone or in combination.

Claims 4-10 and 15-18

Applicants respectfully disagree with the Examiner's assertion that the Yamamoto reference teaches determining fees by escalating them based on usage or making them conditional. Applicants have reviewed the sections of the Yamamoto patent cited by the Examiner in support of this argument (abstract, figs 4 and 7, column 11 lines 45-64, column 12 lines 35-59) and respectfully disagree that this, or any other portion of the Yamamoto patent teaches the embodiment of determining fees by escalating them based on usage or making them conditional. Nowhere in the Yamamoto patent is such an embodiment taught or suggested. Nor does the Council patent teach or suggest determining fees by escalating them based on usage or making them conditional. Further, the Examiner has not pointed to a specific teaching or suggestion in the prior art that would have motivated one of ordinary skill in the art to modify the Yamamoto patent in view of the Council patent to perform the step of determining fees by escalating them based on usage or making them conditional. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 4-10 and 15-18.

Claims 19, 22, 31, 49, and 50

Applicants respectfully assert that the Yamamoto and Council patents fail to teach, suggest, or render obvious, either alone or in combination, embodiments of the present invention

as claimed in independent claims 19, 22, 31, 49, and 50. Claims 19, 22, 31, 49, and 50 are patentable for reasons similar to those given for independent claim 1 above.

Claims 2-3, 11-14, 20-21, 23-30, 32-48, and 51-67

Claims 2-3, 11-14, 20-21, 23-30, 32-48, and 51-67 are believed patentable at least as depending from patentable base claims.

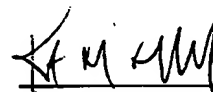
Conclusion

Because both the Yamamoto and Council references fail to teach a number of features of independent claims 1, 19, 22, 31, 49 and 50, Applicants respectfully submit that the references (either alone or in combination) fail to teach or suggest embodiments of the present invention as recited in the claims as amended. With regard to Applicants' dependent claims, Applicants respectfully submit that all of the dependent claims are patentable at least as depending from the amended independent claims discussed above.

For the foregoing reasons it is respectfully submitted that all of the claims are in condition for allowance and the Examiner's early re-examination and reconsideration are therefore kindly requested. Applicants respectfully request allowance of pending claims 1-67. Applicants' silence with respect to other comments made in the Office Action does not imply agreement with those comments. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact Kurt M. Maschoff using the information provided below.

Respectfully submitted,

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Date



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APPENDIX A

AMENDED CLAIMS SHOWING CHANGES RELATIVE TO PREVIOUS VERSIONS

1. (Twice Amended) An address system comprising:
 - means for monitoring information sent by a sender and asynchronously received at a public fee address associated with a mail recipient;
 - means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the mail recipient;
 - means for collecting the fee from the sender into a first account;
 - means for forwarding the information received at the public fee address to a private address associated with the mail recipient; and
 - means for transferring the collected fee[s] to a second account.

19. (Twice Amended) An address system comprising:
 - means for monitoring information sent by a sender and asynchronously received at a public fee address associated with a mail recipient;
 - means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the mail recipient and the fee is conditional;
 - means for collecting the fee from the sender; and
 - means for forwarding the information received at the public fee address to a private address associated with the mail recipient.

22. (Twice Amended) A method of providing a fee address system comprising the steps of:
 - receiving information sent by a sender at a public fee address in a computer, wherein the public fee address is associated with a mail recipient;
 - determining a fee for the information, wherein the fee is based upon a preferences record defined by the mail recipient and the fee increases as information size increases;
 - collecting the fee from the sender; and
 - forwarding the information from the public fee address to a private address associated with the mail recipient.

31. (Twice Amended) A programmed computer for providing a fee address system comprising:

a memory having at least one region for storing computer executable program code; and
a processor for executing the program code stored in memory, wherein the program code includes:

code to receive mail sent by a sender to a public fee address associated with a mail recipient;

code to determine a fee for the mail, wherein the fee is based upon a preferences record defined by the mail recipient;

code to collect the fee from the sender into a first account;

code to forward the mail from the public fee address to a private address associated with the mail recipient; and

code to transfer the collected fee[s] to a second account.

49. (Twice Amended) Computer executable software code stored on a computer readable medium, the code for providing a fee address system, comprising:

code to receive a communication sent by a sender to a public fee address associated with a mail recipient;

code to determine a fee for the communication, wherein the fee is based upon a preferences record defined by the mail recipient;

code to collect the fee; and

code to forward the communication from the public fee address to a private address associated with the mail recipient.

50. (Twice Amended) A method of providing a fee address system comprising the steps of:
receiving mail sent by a sender to a public fee address in a computer wherein the public fee address is associated with a mail recipient;

determining a fee for the mail, wherein the fee is based upon a preferences record defined by the mail recipient;

collecting the fee from the sender into a first account;